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10/816,545

03/31/2004

Barry L. Klein

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09/28/2006

WESTERN DIGITAL TECHNOLOGIES, INC.

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EXAMINER

CAO, CHUN

ART UNIT

PAPER NUMBER

2115

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/816,545 | Applicant(s) KLEIN, BARRY L. | |
| | Examiner Chun Cao | Art Unit 2115 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/11/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-37 are presented for examination.
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The current title is imprecise.

Oath/Declaration

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

- a) It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either an application data sheet or supplemental oath or declaration.
 - b) It does not identify the mailing address of each inventor. A mailing address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing address should include the ZIP Code designation. The mailing address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.
4. Applicant is now required to submit a substitute declaration or oath to correct the deficiencies set forth in this communication. The substitute oath or declaration must be filed within the **THREE MONTH** shortened statutory period set for reply in the "Notice of Allowability" (PTO-37). Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136. Failure to timely file the substitute declaration (or oath) will result in **ABANDONMENT** of the application. The transmittal letter accompanying the declaration (or oath) should indicate the date of the "Notice of Allowance" (PTOL-85)

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and the application number in the upper right hand corner.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 20 and 36 contain the trademark/trade name "*FirewireTM*". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe "data cable" and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 1-6, 8-26 and 28-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (Chen), U.S. publication no. 2005/0015477 A1 in view of Applicant Admitted Prior Art (AAPA).

As per claim 1, Chen teaches a method of remotely power cycling a peripheral data storage system from a host system [figures 2,3], the method comprising:

Powering-up the peripheral data storage system from the host system based on a host-scheduled backup operation [fig. 3; paragraphs 0028-0031];

Transmitting data to the peripheral data storage system from the host system based on the host-scheduled backup operation [paragraphs 0004, 0016]; and

Powering-down the peripheral data storage system from the host system based on the host-scheduled backup operations [fig. 2; paragraphs 0024-0027].

Chen does not explicitly teach of transmitting pre-selected data to the peripheral data storage system from the host system.

Official Notice is taken that transmit pre-selected data to the peripheral data storage system from the host system is very well known in the computer art. Such as AAPA teaches of transmitting pre-selected data to the peripheral data storage system from the host system [page 1, paragraph 0003].

It would have been obvious to one of ordinary skill in the art at time the invention to combine the teachings of Chen and AAPA, the specify teachings of AAPA stated above would improve the performance of the Chen system by backing up only the selected data.

As per claim 2, Chen teaches that the powering-up is performed periodically at a pre-scheduled time corresponding to the host-scheduled backup operation [paragraph 0020, 0022].

As per claim 3, Chen teaches of transmitting a power-up command to the peripheral data storage system for powering-up the peripheral storage system [fig. 3; paragraphs 0028-0031].

As per claim 4, Chen teaches of transmitting a power-down command to the peripheral data storage system for powering-down of the peripheral data storage system [fig. 2; paragraphs 0024-0027].

As per claim 5, Chen teaches of supplying operating power to the peripheral data storage system from the host system [fig. 1; paragraph 0023].

As per claim 6, Chen teaches of ceasing the supplying of operating power to the peripheral data storage system from the host system [fig. 2; paragraphs 0024-0027].

As per claim 8, Chen discloses a peripheral data storage device, a peripheral system controller and a peripheral system controller host interface adapted for communication with the host system [fig. 1].

As per claim 9, Chen teaches of powering-up the peripheral storage system [fig. 3; paragraphs 0028-0031].

As per claim 10, Chen teaches of powering-down of the peripheral data storage system [fig. 2; paragraphs 0024-0027].

As per claim 11, Chen teaches of transmitting a power-up command to the peripheral data storage system for powering-up the peripheral storage system [fig. 3; paragraphs 0028-0031].

As per claim 12, Chen teaches of supplying power to the peripheral data storage system from an external power supply source [fig. 1; paragraph 0023].

As per claim 13, Chen teaches of transmitting a power-down command to the peripheral data storage system for powering-down of the peripheral data storage system [fig. 2; paragraphs 0024-0027].

As per claim 14, Chen teaches of ceasing the supplying of operating power to the peripheral data storage system from the host system [fig. 2; paragraphs 0024-0027].

As per claim 15, Chen discloses an external disk drive [fig. 1; paragraph 0016].

As per claim 16, AAPA teaches the pre-selected data resides in the host data storage system [page 1, paragraph 0003].

As per claim 17, Chen teaches of configuring the host-scheduled backup operation in the host system prior to the powering-up [paragraph 0020].

As per claim 18, AAPA teaches pre-selecting a portion of host data for the host-scheduled backup operations of the selected portion to the peripheral data storage system [page 1, paragraph 0003].

As per claim 19, AAPA teaches that the host system is adapted for communication with the peripheral data storage system via a USB cable [page 1, paragraph 0002].

As per claim 20, AAPA teaches that the host system is adapted for communication with the peripheral data storage system via a Firewire cable [page 1, paragraph 0002].

As per claim 37, Chen discloses that the peripheral data storage system controller is a bridge controller and the peripheral data storage controller host interface is a bridge controller host interface [fig. 1].

8. Claims 7, 8, 15, 27 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (Chen), U.S. publication no. 2005/0015477 A1 in view of Applicant Admitted Prior Art (AAPA) and Serichol Blasco (Blasco), US patent no. 6,892,288.

Chen and AAPA do not explicitly teach of determining if the transmitted pre-selected data were stored in the peripheral data storage system. In other word, they do not teach of determining whether the backup process is completed.

Official Notice is taken that the limitation is very well known in the computer art. Such as Blasco teaches of determining the backup process is completed [col. 2, lines 1-5, 25-31].

It would have been obvious to one of ordinary skill in the art at time the invention to combine the teachings of Chen and AAPA and Blasco, because they teach of backing up data in a data storage system, the specify teachings of Blasco stated above would improve the reliability of the Chen system by preventing power off the storage system prior to backing up data is completed.

As per claim 8, Blasco discloses a peripheral data storage device, a peripheral system controller and a peripheral system controller host interface adapted for communication with the host system [fig. 1].

As per claim 15, Blasco discloses an external disk drive [3, fig. 1].

As to claims 21-36 are contained the same limitations as claims 1-20. Therefore, same rejection is applied.

As per claim 37, Blasco discloses that the peripheral data storage system controller is a bridge controller and the peripheral data storage controller host interface is a bridge controller host interface [fig. 1].

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chun Cao whose telephone number is 571-272-3664. The examiner can normally be reached on Monday-Friday from 7:30 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas C. Lee can be reached on 571-272-3667. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sep. 25 2006



**CHUN CAO
PRIMARY EXAMINER**